REMARKS

This Application has been carefully reviewed in light of the final Office Action mailed July 12, 2004 (the "Office Action"). At the time of the Office Action, Claims 1, 3, 4, 6-11, 13, 14, 16-31, and 33-38 were pending in this patent application and stand rejected. Applicants amend Claim 31 to correct a typographical error. Applicants respectfully request reconsideration and favorable action in this case.

Double Patenting

The Examiner has indicated that Claims 1, 3, 4, 6-11, 13, 14, 16-31, and 33-38 conflict with Claims 1-32 of Application Serial No. 09/470,588. As noted in the previous response, Applicants will maintain a clear demarcation between the applications. Moreover, Applicants will file a terminal disclaimer when appropriate and necessary.

Claim Rejections – 35 U.S.C. §103

The Examiner rejects Claims 1, 3, 4, 6-11, 13, 14, 16-31, and 33-38 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,791,991 to Small ("*Small*") in view of U.S. Patent No. 6,330,544 to Walker et al. ("*Walker*") and U.S. Patent No. 6,039,244 to Finsterwald ("*Finsterwald*"). Applicants respectfully submit that the claims, as presently presented, include numerous limitations not shown or suggested by *Small*, *Walker*, or *Finsterwald*, whether taken alone or in combination. For example, consider Claim 1, which recites:

> 1.   A computer-based interface for facilitating rebate processing, the interface operable to:
> display a plurality of product identifiers using the computer-based interface, wherein each of the product identifiers is associated with a product bearing a rebate;
> receive purchase information from a user, wherein the purchase information identifies a purchased product associated with a selected one of the product identifiers;
> receive a rebate request for a rebate on the purchased product, the rebate request having an associated rebate transaction identifier assigned by a remote rebate processing center;
> retrieve status information for the rebate request from the remote rebate processing center using the rebate transaction identifier;

        display the status information;
        receive authorization of the rebate request;
        display rebate information retrieved from the remote rebate processing center, the rebate information comprising at least two disbursement options determined based on the purchase information, a first one of the disbursement options having a first cash value to a recipient and a second one of the disbursement options having a second cash value to a recipient, the first cash value different than the second cash value; and
        receive a selection of the disbursement options.

To sustain the rejection of Claim 1, the Office Action stitches together random, unrelated excerpts from the three cited references. Applicants respectfully submit that this violates basic requirements for sustaining any rejection. In addressing Applicants' claims, the claims must be considered as a whole. *See* M.P.E.P. § 2141 (stating that: "When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to: (A) The claimed invention must be considered as a whole . . .."); *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 (Fed. Cir. 1986). Applicants respectfully submit that the piecemeal reconstruction of Claim 1 is thus in contravention of established tenets of patent law. Also, Applicants respectfully submit that the cited portions of the references, upon examination, do not even teach or suggest the individual elements of Claim 1, let alone the claim elements when considered as a whole.

For example, consider the portion of Claim 1 requiring that the interface for rebate processing be capable of displaying status information for a rebate request retrieved from a remote rebate processing center using a rebate transaction identifier. *Small*, the primary reference in this rejection, simply discloses a bingo game that can bring coupon and rebate information to the attention of a consumer. While *Small* mentions that rebate forms may be submitted for processing, *Small* fails to address any aspects of rebate processing that may take place following such a submission. Thus understandably, *Small* fails to mention providing any status for a rebate request, let alone rebate request status as required by Claim 1. The Examiner therefore turns to the disclosures of *Walker* and *Finsterwald* in an attempt to show these claimed aspects, stating:

        While <u>Small</u> does not disclose retrieving and display [sic] status information for the rebate request, <u>Walker</u> discloses maintaining a "status" field in the database to indicate the status of a rebate, e.g.

> [sic] issued, redeemed, etc. <u>Finsterwald</u> discloses another similar rebate processing system in which that [sic] status of the rebate request is displayed to the user (col 10, lines 21-25). Therefore, it would have been obvious to one of skill in the art at the time the invention was made to notify the customer in <u>Small</u> of the current status of the rebate request, such as approved, denied, processing, etc. One would have been motivated to notify the customer of the status of the rebate in order to provide better customer service and to enable the customer to provide additional information if needed.

Office Action, at pages 6-7 (underline in original). However, upon review, it is clear that neither *Walker* nor *Finsterwald* teach or suggest anything like the rebate request status of Claim 1.

In general, *Walker* discloses a system for combining gift certificates or redemption vouchers with credit card processing systems. *Walker*, at column 4, lines 11-13. *Walker* teaches, among other things, a certificate database that stores information regarding certificates corresponding to customer accounts. *See Walker*, Figure 5 and column 12, line 59 - column 13, line 44. For example, *Walker*'s figure 5 depicts a table identifying three certificates corresponding to three different customer accounts. For each certificate, the table indicates a maximum value of the certificate and a "STATUS" indicating whether the certificate has been "ISSUED" or "REDEEMED." However, *Walker*'s "STATUS" is not status information <u>for a rebate request</u>. Further, *Walker* does not show a user interface that can retrieve status information for a rebate request using a rebate transaction identifier assigned for the rebate request, nor does *Walker* show a user interface that can display the status information for the rebate request.

Similarly, *Finsterwald* fails to teach these claimed aspects. In general, *Finsterwald* teaches specific techniques for enabling rebate or coupon systems. More specifically, *Finsterwald* teaches a system that generates unique codes and then distributes these codes to consumers purchasing particular products. See, e.g., *Finsterwald*, at column 1, lines 41-65. A consumer, having received a unique code at purchase, can then submit the code to receive "points" that may later be redeemed for other products or services. *Finsterwald*, at column 2, lines 19-33. The *Finsterwald* system may store these points in an account created for the consumer. *Finsterwald*, at column 9, lines 16-25. The Examiner cites to this point account as somehow teaching claim elements related to the status information for a rebate request.

Specifically, the Examiner cites to a portion of *Finsterwald* that discloses how a customer can check the balance of the point account, the cited portion of *Finsterwald* stating:

> When the customer 14 wishes to learn the state of his point account, or to trade in the collected points against a reward, then he can enter into contact with the data collecting station 1 via the Internet connection 19 and trigger the desired action.

Finsterwald, at column 10, lines 21-25. The Examiner characterizes this excerpt from *Finsterwald* as showing a "rebate processing system in which [the] status of the rebate request is displayed to the user." However, as with *Walker*, *Finsterwald*'s point account balance is not status information <u>for a rebate request</u>. Further, *Finsterwald* does not show a user interface that can retrieve status information for a rebate request using a rebate transaction identifier assigned for the rebate request, nor does *Finsterwald* show a user interface that can display the status information for the rebate request.

In an attempt to further bolster the teachings of *Walker* and *Finsterwald*, the Examiner states:

> Furthermore, it is common in a wide variety of applications to maintain, retrieve, and display status information about business transactions from tracking information in package delivery systems to loan status information in loan processing systems to purchase order status information in purchasing systems, etc.

Office Action, at page 10. First, this statement fails to establish that any "common" art teaches or suggests the status information for a rebate request as claimed. Furthermore, to the extent that the Examiner maintains this assertion based on "Official Notice," "well known prior art," "common knowledge," or other information within the Examiner's personal knowledge, Applicants respectfully request that the Examiner cite a reference in support of this position or provide an affidavit in accordance with M.P.E.P. § 2144.03 and 37 C.F.R. § 1.104(d)(2).

To summarize, the Examiner attempts to show that *Walker* and *Finsterwald* together teach or suggest a computer-based user interface operable, in part, to retrieve status information for a rebate request from a remote rebate processing center using a rebate transaction identifier assigned by the remote rebate processing center, and further operable to display the status information. The Examiner attempts to show the status information for the

rebate request using a combination of *Walker*'s status of whether or not a certificate has been redeemed with *Finsterwald*'s brief disclosure of access to a point account balance. Applicants respectfully submit that neither of these disclosures deal with status information for a rebate request, nor do these disclosures teach or suggest the claimed aspects related to the status information for a rebate request.

Also, the aspects of the rebate request status retrieval requirements of Claim 1 are intertwined with the other elements of the claim, such as "the rebate request," "the remote rebate processing center," and "the rebate transaction identifier." For example, consider another specific requirement of Claim 1 that "the rebate request hav[e] an associated rebate transaction identifier assigned by a remote rebate processing center." Not only do the references fail to teach these elements, but the Examiner's use of unrelated excerpts from the three cited references fails to account for the interrelated nature and full meaning of these claim terms when Claim 1 is considered as a whole.

Thus Applicants respectfully submit that the piece by piece reconstruction of Applicants' Claim 1 using, in many instances, unrelated portions of three very different references is improper in light of the basic tenets of patent law. Also, even ignoring the impermissible assembly of random excerpts, Applicants respectfully submit that the cited references, even when combined, fail to show all of the elements of Claim 1.

For substantially the same reasons discussed above, Applicants respectfully submit that the *Small-Walker-Finsterwald* combination, as applied to independent Claims 11, 21, and 31, is similarly inappropriate and insufficient to show obviousness. Therefore, Applicants respectfully request the Examiner to reconsider and withdraw the rejection to Claims 1, 11, 21, and 31 and their respective dependent claims based upon the *Small-Walker-Finsterwald* combination.

Conclusions

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending claims. If the Examiner feels that a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicants stands ready to conduct such a conference at the convenience of the Examiner.

The Commissioner is hereby authorized to charge any other fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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